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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/701,889
Filing Date: November 05, 2003
Appellant(s): HALLIGAN ET AL.

MAILED

JAN 19 2007

GROUP 3600

Jon P. Christensen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 12, 2006 appealing from the Office action mailed November 14, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2003/0158745 Katz et al 08-2003

USPN 6,167,397 Jacobson et al 12-2000

Merriam-Webster's Collegiate Dictionary, Tenth Edition, 1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (US 2003/0158745), in view of Jacobson et al (USPN 6,167,397).

As per claim 1, Katz et al disclose a method of discovering trade secrets of an organization (i.e., system for a company to develop and maintain intellectual capital, ¶ 0005, including trade secret information, ¶ 0034), such method comprising the

Art Unit: 3623

steps of: collecting sets of descriptive information about potential trade secrets through an input device of a computer from a plurality of persons of the organization (i.e., user enters information regarding new innovation via tab 500, ¶ 0040), and generating a report containing the non-redundant descriptive information about potential trade secrets of the organization (i.e., innovations folder 600, containing one entry for each innovation, ¶ 0043). Katz et al does not disclose analyzing the collected sets of descriptive information about potential trade secrets using logical and mathematical formulae to identify and eliminate any redundancy among the sets of descriptive information about potential trade secrets to define a collection of descriptive information about potential trade secrets of the organization. Jacobson et al discloses an algorithm for clustering of documents matching queries based on occurrence of terms, whereby weighing the terms using a standard measure results in identification of a small number of clusters (i.e., defining a collection of similar documents, column 2, lines 46-52). In addition, Jacobson et al discloses the clustering of documents employed as a post search analytical tool (column 6, lines 19-23), thereby supplementing the Katz et al innovations query page 1200 (¶ 0050). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the elimination of redundancy via the clustering of documents in Katz et al, as seen in Jacobson et al, as an efficient means of searching in a set of structured documents.

As per claim 2, Katz et al disclose correlating among the sets of descriptive information about potential trade secrets having at least some redundant entries to

identify sets of descriptive information about potential trade secrets that are related by redundancy and sets of descriptive information about potential trade secrets that are unrelated (i.e., the innovation query page 1200 allows the user to execute searches based upon various attributes of the abstract, ¶ 0050). Katz et al does not explicitly disclose integrating redundant entries among the respective sets into compiled sets of descriptive information about potential trade secrets with non-redundant entries that together with the sets of descriptive information about potential trade secrets with unrelated entries define a collection of descriptive information about potential trade secrets. Jacobson et al provides for clustering of documents matching queries based on occurrence of terms, whereby weighing the terms using a standard measure results in identification of a small number of clusters (i.e., defining a collection of similar documents, column 2, lines 46-52). Further, Jacobson et al disclose an infrequent matching, where a document and record may be joined based on a high probability of being semantically related (column 7, lines 6-10). In addition, Jacobson et al discloses the clustering of documents employed as a post search analytical tool (column 6, lines 19-23), thereby supplementing the Katz et al innovations query page 1200 (¶ 0050). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include integrating redundant entries with non-redundant entries in Katz et al, as seen in Jacobson et al, as an efficient means of searching in a set of structured documents.

As per claims 3 and 6, Katz et al disclose conducting interviews of each person of the plurality of persons over an electronics communications network (e.g., information acquired from users via network 10, ¶ 0033).

As per claim 4, Katz et al disclose downloading a web form containing a plurality of information entry fields that request trade secret information from each person of the plurality of persons (i.e., users accesses web pages via user interface and access new innovation page 500, ¶¶ 0039, 0043).

As per claim 5, Katz et al disclose collecting information from each person of the plurality of persons regarding the identities of a plurality of other persons who may have information about the trade secrets of the organization (i.e., peernet access link 618 that allows users to locate and store profiles of professionals with expertise in the particular innovation, ¶ 0058).

As per claim 7, Katz et al disclose downloading a web form containing a plurality of information entry fields that request said identities from each person of the plurality of persons (i.e., users accesses web pages via user interface and access peernet access link 618 that allows users to locate and store profiles of professionals with expertise in the particular innovation, ¶¶ 0043, 0058).

As per claim 8, Katz et al disclose collecting information from each person of the plurality of persons regarding the locations of the trade secrets of the organization (i.e., locations of trade secrets may be found in innovations folder 600, ¶ 0043).

As per claim 9, Katz et al disclose conducting interviews of each person of the plurality of persons over an electronics communications network (i.e., user entered

information, based on template of main page 40 and new innovation page 500, maintained by network administrator, ¶¶ 0038-39) .

As per claim 10, Katz et al disclose downloading a web form containing a plurality of information entry fields that request said information on locations from each person of the plurality of persons (i.e., users accesses web pages via user interface and innovations folder 600, ¶¶ 0043-44).

As per claim 11, Katz et al disclose the step of correlating further comprises matching respective information entry fields of the plurality of fields of the trade secret information entries and marking trade secret information entries with matching fields as belonging to a single potential trade secret group (i.e., matched entries are listed in order of relevance to the search terms and saved in the internal abstracts folder based on the selected innovation, ¶ 0057).

As per claim 12, Katz et al disclose a field for a subject matter of the trade secret (i.e., abstract 1204, ¶0050).

As per claim 13, Katz et al disclose a field for a format of the trade secret (i.e., general classification 1214, ¶ 0050).

As per claim 14, Katz et al disclose a field for a product or service enhanced by the trade secret (i.e., applications, ¶ 0050) .

As per claim 15, Katz et al disclose the step of correlating further comprises performing key word searching of the plurality of fields of each potential trade secret group (i.e., user submits search query S104 and determines where to search S106, figure 14).

As per claim 16, Katz et al does not disclose improving the performance of said correlation by replacing any keywords encountered that are associated with a corresponding master keyword in a table of synonym keywords with the corresponding master keyword. Jacobson et al disclose an attribute/value index, wherein a collection of attributes is stored (i.e., master index) and matched at a later time, similar to a table to synonym keywords. In addition, Jacobson et al discloses the clustering of documents employed as a post search analytical tool (column 6, lines 19-23), thereby supplementing the Katz et al innovations query page 1200 (¶ 0050). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a table of synonym keywords in Katz et al, as seen in Jacobson et al, as an efficient means of searching in a set of structured documents.

As per claims 17-18, Katz et al does not disclose subdividing each potential trade secret group into more specific sub-groups based on the analysis of keywords contained in the plurality of fields and where each sub-group has at least a predefined number of keywords in common. Jacobson et al disclose documents clusters created and scored based upon the diversity of matches of documents (column 3, lines 12-15). In addition, Jacobson et al discloses the clustering of documents employed as a post search analytical tool (column 6, lines 19-23), thereby supplementing the Katz et al innovations query page 1200 (¶ 0050). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the analysis of keywords where each sub-

group has at least a predefined number of keywords in common in Katz et al, as seen in Jacobson et al, as an efficient means of searching in a set of structured documents.

As per claims 19-20, Katz et al does not disclose using common keywords from keyword fields of multiple potential trade secret entries and using non-common keywords and their frequency of occurrence in the keyword field of multiple potential trade secret entries being integrated as a common/non-common keyword field in the resulting non-redundant trade secret entry. Jacobson et al disclose determining the similarity between documents by determining the co-occurrence of infrequently occurring (i.e., non-common) terms in the vicinity of query (i.e., common) keywords (column 3, lines 63-67). In addition, Jacobson et al discloses the clustering of documents employed as a post search analytical tool (column 6, lines 19-23), thereby supplementing the Katz et al innovations query page 1200 (¶ 0050). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include using common and non-common keywords and their frequency of occurrence in Katz et al, as seen in Jacobson et al, as an efficient means of searching in a set of structured documents.

As per claims 21-23, Katz et al does not disclose forming predetermined mathematical quantities, an arithmetic mean, or a standard deviation to represent a characteristic value and an error range for each numerical field of the plurality of trade secret entries being integrated. Jacobson et al disclose using statistically and logarithm analysis to achieve a flattening effect that gives importance to the number

of term occurrences (column 3, lines 37-41). In addition, Jacobson et al discloses the clustering of documents employed as a post search analytical tool (column 6, lines 19-23), thereby supplementing the Katz et al innovations query page 1200 (¶ 0050). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include forming predetermined mathematical quantities, an arithmetic mean, or a standard deviation to represent a characteristic value and an error range in Katz et al, as seen in Jacobson et al, as an efficient means of searching in a set of structured documents.

As per claims 24-26, Katz et al disclose generating data mining signatures, content filtering signatures, or electronic document scanning signatures from the collected trade secret information, or by the results of logical or mathematical formulae applied thereto (i.e., various levels of access determine how much of each entry can be viewed, based upon password and user-defined access control, ¶¶ 0034, 0041).

Claims 27-52 are rejected based upon the rejection of claims 1-26, since they are the programmed computer claims corresponding to the method claims.

(10) Response to Argument

In the Appeal Brief, Appellant argues that 1) neither Katz nor Jacobson, either alone or in combination, teach or suggest the elimination of redundant or identical entries, 2) claims 1 and 27 are limited to analyzing the collected sets of descriptive information about potential trade secrets using logical and mathematical formulae to

Art Unit: 3623

identify and eliminate any redundancy among the sets of descriptive information about potential trade secrets to define a collection of descriptive information about potential trade secrets of the organization, and that since Katz et al merely creates a database and method for accessing the database and Jacobson et al merely provides a method of clustering identifiers of documents, the combination fails to teach or suggest each and every claim limitation, 3) claims 2 and 28 are limited to integrating redundant entries among the respective sets into compiled sets into compiled sets of trade secret information, and that since Katz et al and Jacobson et al both deal with static databases, there is no integration of redundant entries as under the claimed invention and 4) a *prima facie* case of obviousness has not bee met, since the Examiner has failed to establish any credible basis for believing that the combination contemplates the reduction and elimination of redundant entries and that the Examiner has failed to provide any basis for why one skill in the art would have been led by the relevant teachings of the applied references to make the proposed combination.

With respect to argument 1, the Examiner respectfully disagrees. First, the Examiner notes that Appellant's specification does not seem to even mention eliminating any redundancy among sets of descriptive information, much less that the elimination of redundancy equates to getting rid of or removing that which exceeds what is normal or necessary, as is now alleged for the first time in Appellant's Appeal Brief. As such, the Examiner submits that Appellant is attempting to define the claim language to be more specific in scope than the specification supports, since the

specification is silent on the elimination of redundancy equates to getting rid of or removing that which exceeds what is normal or necessary.

Moreover, Merriam-Webster's Collegiate Dictionary, Tenth Edition, (see Appendix A) also defines eliminate as "to set aside as unimportant," or "ignore." Jacobson et al accomplishes this by discloses clustering of documents, based upon a query, that share common terms (column 2, lines 46-50 and column 3, lines 8-12), wherein the aim of document clustering techniques is to identify document-clusters such that any document in the cluster is representative of the set of all documents in the cluster (column 5, lines 60-63). As such, Jacobson et al discloses one document representing all the documents, thus setting aside or ignoring the other documents. Further, Jacobson et al discloses having created the cluster of documents the user is then presented with an identification of the individual clusters and the user can then select any one of the clusters for examination (column 6, lines 9-12). As a result, Jacobson et al indeed eliminates redundancy via clustering of similar documents.

With respect to argument 2, the Examiner respectfully disagrees. First, it is noted that Appellant merely alleges that the combination of Katz et al, in view of Jacobson et al fails to teach or suggest each and every element of the claim limitation, without pointing specifically to what is not taught and why the cited portion of the references fail to teach the claim limitations. In addition, Jacobson et al discloses an algorithm for clustering of documents matching queries based on occurrence of terms, whereby weighing the terms using a standard measure results in identification of a small number of clusters (i.e., defining a collection of similar documents, column 2, lines 46-

52). Moreover, Jacobson et al discloses the clustering of documents employed as a post search analytical tool (column 6, lines 19-23), thereby supplementing the Katz et al innovations query page 1200 (¶ 0050), thus indeed teaching the claimed limitation. Further, as seen in the discussion with respect to argument 1, Jacobson et al indeed eliminates redundancy via clustering of similar documents.

With respect to argument 3, the Examiner respectfully disagrees. First, it is noted that Appellant merely alleges that the combination of Katz et al, in view of Jacobson et al fails to teach or suggest each and every element of the claim limitation, without pointing specifically to what is not taught and why the cited portion of the references fail to teach the claim limitations. In addition, Jacobson et al provides for clustering of documents matching queries based on occurrence of terms, whereby weighing the terms using a standard measure results in identification of a small number of clusters (i.e., defining a collection of similar documents, column 2, lines 46-52). Moreover, contrary to Appellant's assertion, the database in Jacobson et al is not static. Rather, Jacobson et al discloses creating clusters of documents, wherein the user is presented with an identification of the individual clusters and can then select any one of the clusters for examination (column 6, lines 9-12). As such, Jacobson et al indeed discloses integration of redundant entries.

With respect to argument 4, the Examiner respectfully disagrees. As discussed above, with respect to argument 1, the combination of Katz et al in view of Jacobson et al indeed contemplates the reduction and elimination of redundant entries. In addition, the Examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Jacobsen et al discloses the clustering of documents employed as a post search analytical tool (column 6, lines 19-23), thereby supplementing the Katz et al innovations query page 1200 (¶ 0050).

Moreover, many times there is neither a motivation to make a modification clearly articulated in the references nor an evident lack of motivation. Rather, the references typically disclose elements or aspects of the claimed invention, but do not specifically point the way toward the combination. As such, a judgment must be made whether "a person of ordinary skill in the art would have had sufficient motivation to combine the individual [elements] forming the claimed [invention]." In re Clinton, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

Lastly, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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January 4, 2007

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Art Unit 3691

Application/Control Number: 10/701,889
Art Unit: 3623

Page 16

Appendix A



Merriam- Webster's Collegiate® Dictionary

TENTH EDITION

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Merriam-Webster, Incorporated
Springfield, Massachusetts, U.S.A.



A GENUINE MERRIAM-WEBSTER

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